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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/895,446	06/29/2001	Peiqi Jiang	ESSR:049US/MBW	9001

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EXAMINER

YOON, TAE H

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 09/25/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/895,446

Applicant(s)

JIANG ET AL.

Examiner

Tae H Yoon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2002, Pre-Amdt.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

The submission of a separate claim reciting a narrow limitation of claim 1 including 'such as the corresponding acid YH gas' is suggested.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The claim 3 is not commensurate in scope with an enabling disclosure until the named groups for "substituted", as described in the instant specification, are recited in the claims for "substituted". If there are no examples for "substituted", in the instant specification, "substituted" must be cancelled because the specification is not enabling for the skilled artisan to practice the invention. It would require undue experimentation to determine all of the groups which are encompassed by "substituted" and how to attach these groups to the claimed compound.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 2, 9, 14, 21, 23 and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recited "the corresponding acid YH gas" in claim 1 is indefinite absent a definition for said Y. The recited "the associated acid YH" in claim 2 lacks an antecedent basis. Improper Markush language is recited in claims 9, 14 and 23 and a

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proper format is "--- selected from the group consisting of A, B, C --- and Z". The recited "0 % by weight" in claims 21 and 25 improperly broadens the scope of claims 20 and 22, respectively, wherein "further comprising" which is a positive amount is recited.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-32 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-31 of U.S. Patent No. 5,973,098 in view of Amagai et al (US Pat. 6,130,307) or EP 0 942 027. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claim 1 of said patent recites "comprising" permitting the presence of other component and because the disclosure on col. 2, lines 9-10 states using an effective amount of a thiocyanate salt as part of the catalyst. Therefore, the utilization of the art well known catalyst such as tertiary amine taught by Amagai et al (col. 8, lines 30-40) or EP ([0030]-[0031]) in said patent'098 would be obvious to one skilled in the art since said patent '098 teaches the use of mixed catalysts and since said tertiary amine is one

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of the art well known catalyst and since the use of catalysts in combination of two or more is a routine practice in the art.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keita et al (US 5,973,098) in view of Amagai et al (US 6,130,307) or EP 0 942 027.

Keita et al teach a polymerizable composition comprising at least one episulfide compound and one or more compounds having two or more functional groups capable of reacting with episulfide groups, and optical lenses thereof in abstract and claims. The use of a polythiol monomer or poly(thio)cyanate monomer and/or crown ether is taught at col. 5, lines 1-23 and in claims 20-21. The instant multi-step process is taught at col. 7, lines 13-46.

The instant invention further recites employing a tertiary amine as a co-catalyst over Keita et al. However, Keita et al state using an effective amount of a thiocyanate salt as part of the catalyst at col. 2, lines 9-10 which permits a co-catalyst.

Amagai et al (col. 8, lines 30-40) and EP 0 942 027 ([0030]-[0031]) teach the instant tertiary amine as a catalyst and a mixture of two or more catalysts.

It would have been obvious to one skilled in the art at the time of invention to utilize the art well known tertiary amine taught by Amagai et al or EP in the composition

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comprising at least one episulfide compound of Keita et al since Keita et al teach a thiocyanate salt as part of the catalyst at col. 2, lines 9-10 which permits a co-catalyst and since the use of a mixture of two or more catalysts is a routine practice in the art absent showing otherwise.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H Yoon whose telephone number is (703) 308-2389. The examiner can normally be reached on Mon-Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Tae H Yoon
Primary Examiner
Art Unit 1714

THY/September 22, 2003